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In re Application of:

HOFMANN, Albrecht, et al.  
U.S. Application No.: 10/511,285  
PCT No.: PCT/DE03/01079  
International Filing Date: 02 April 2003  
Priority Date: 18 May 2002  
Attorney's Docket No.: 2998  
For: SYSTEM COMPRISING A TOOL  
RETAINER

DECISION ON PETITIONS  
UNDER 37 CFR 1.137(b) AND 37  
CFR 1.47(a) AND RENEWED  
SUBMISSION UNDER  
37 CFR 1.42

The present decision is issued in response to the "Petition To Revive" and accompanying materials filed 17 January 2007, treated herein as a petition for revival under 37 CFR 1.137(b), a renewed submission under 37 CFR 1.42, and a petition under 37 CFR 1.47(a) for acceptance of the declaration without the signature of the legal representative of the deceased inventor. Deposit Account No. 19-4675 will be charged the petition fee required for the petition under 37 CFR 1.137(b).

**BACKGROUND**

The procedural background for the present application was set forth in the communication mailed herein on 23 November 2005. That communication informed applicants that the declaration filed 14 October 2004 was unacceptable under 37 CFR 1.42 because the legal representative of the deceased inventor did not execute the declaration. The communication provided applicants with an extendable two-month deadline to submit "an oath or declaration executed on behalf of the deceased inventor in compliance with 37 CFR 1.42 and including all the information required under 37 CFR 1.497."

Applicants did not file a response during the available time period. Accordingly, the present application became abandoned at midnight on 23 January 2006 for failure to file a proper and timely response to the communication mailed 23 November 2005.

On 17 January 2007, applicants filed the "Petition To Revive" and accompanying materials considered herein. The petition includes a revised declaration submitted on behalf of the deceased inventor (treated herein as a renewed submission under 37 CFR 1.42), and an assertion that the legal representative of the deceased inventor has refused to execute the declaration (treated herein as a petition under 37 CFR 1.47(a)).

## DISCUSSION

Under 37 CFR 1.137(b), a petition requesting that an application be revived on the grounds of unintentional delay must be accompanied by: (1) the required reply, (2) the petition fee required by law, (3) a statement that the "entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition was unintentional," and (4) any terminal disclaimer and fee required pursuant to 37 CFR 1.137(c).

With respect to item (1), the "required reply" in the present circumstances is a proper response to the 23 November 2005 communication, that is, an acceptable declaration executed on behalf of the deceased inventor. The present submission includes a declaration that identifies the inventors herein and the legal representative of the deceased inventor, but the legal representative of the deceased inventor did not execute the declaration. Rather, applicants state that the legal representative is refusing to execute the declaration. Under such circumstances, a grantable petition under 37 CFR 1.47(a) is required before the declaration can be accepted.

A grantable petition under 37 CFR 1.47(a) in these circumstances must include: (a) the fee under 37 CFR 1.17; (b) a statement of the last known address of the non-signing legal representative of the deceased inventor; (c) an oath or declaration executed by the other inventors on behalf of themselves and the deceased inventor's legal representative; and (d) factual proof that the legal representative refuses to execute the application or cannot be reached after diligent effort. The present submission satisfies only item (c). Applicants have not submitted the required \$200 petition fee, have not expressly stated the last known address of the non-signing legal representative, and have failed to provide any evidence with respect to the purported refusal of the legal representative to execute the declaration. It is noted that the present submission states "applicant has previously satisfactorily proven that the legal representative is refusing to sign the declaration on behalf of the deceased inventor," however, it is not clear to what applicants are referring, as the present application file contains no materials addressing any purported refusal to sign by the legal representative (see MPEP section 409.03(d) as to the evidence required to demonstrate that the legal representative cannot be located after diligent effort or refuses to execute the declaration).

Based on the above, applicants have not submitted a grantable petition under 37 CFR 1.47(a) for acceptance of the declaration without the signature of the legal representative of the deceased inventor. The declaration filed with the present submission is therefore not an acceptable response to the communication mailed herein on 23 November 2005. Accordingly, applicants have not satisfied the "required reply" element of a grantable petition to revive under 37 CFR 1.137(b).

As for the remaining elements of a grantable petition under 37 CFR 1.137(b), based on applicant's authorization, Deposit Account No. 19-4675 will be charged the required petition fee, satisfying item (2).

With respect to item (3), the statements in the petition are being construed as the statement required by 37 CFR 1.137(b)(3), that is, a statement that the "entire delay in filing the required reply from the due date for the required reply until the filing of a grantable petition

under 37 CFR 1.137(b) was unintentional." Petitioner must notify this office immediately if this is **not** a correct interpretation of such statements. Based on the above interpretation, item (3) is considered satisfied.

Item (4) does not apply to the present application.

Based on the above, applicants have failed to submit all the requirements for a grantable petition to revive under 37 CFR 1.137(b).

### CONCLUSION

The petition for revival under 37 CFR 1.137(b) is **DISMISSED** without prejudice. The application remains abandoned.

The petition under 37 CFR 1.47(a) for acceptance of the declaration without the signature of the legal representative of the deceased inventor is **DISMISSED** without prejudice.

The renewed request for status under 37 CFR 1.42, which consisted of the submission of a revised declaration that was not signed by the legal representative of the deceased inventor and was not accompanied by a grantable petition for acceptance of the declaration without the signature of the legal representative, is **DISMISSED** without prejudice.

Any request for reconsideration of this decision must be filed within **TWO (2) MONTHS** of the mail date of the present decision, and it must include the "required reply" necessary to satisfy the remaining element of a grantable petition under 37 CFR 1.137(b), that is: (1) a declaration in compliance with 37 CFR 1.497 and 1.42 that is executed on behalf of the deceased inventor by his legal representative; or (2) the materials required to satisfy the outstanding requirements for a grantable petition under 37 CFR 1.47(a) for acceptance of the declaration without the signature of the non-signing legal representative, as discussed above and in the MPEP.

Please direct further correspondence with respect to this matter to Mail Stop PCT, Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.



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